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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/484,838	06/07/1995	STEVEN F. FABIJANSKI	33229-324-PI	4954

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EXAMINER
FOX, DAVID T

ART UNIT	PAPER NUMBER
1638	22

DATE MAILED: 07/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/484,838	Fabijanski et al
Examiner	**Group Art Unit**
FOX	1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 5/1/01.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1, 3-7 and 9-16 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1, 3-7 and 9-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1638.

Interference No. 103,885 involving parent application Serial No. 08/276,510 has been terminated by a decision adverse to applicant. *Ex parte* prosecution is resumed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-7 and 9-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No.

5,356,799. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the methods for producing hybrid seed comprising crossing a male sterile plant, transformed with an antisense gene which renders pollen-producing cells susceptible to an antibiotic or herbicide, with a male fertile plant which comprises a sense antibiotic- or herbicide-resistance gene which negates the disruption caused by the antisense sequence, and the resultant hybrid seed, as claimed in the patent, to obtain the methods for producing hybrid seed comprising crossing a male sterile plant, transformed with an antisense gene which renders pollen-producing cells susceptible to an antibiotic or herbicide, with a male fertile plant which negates the disruption caused by the antisense sequence, and the resultant hybrid seed, as claimed in the instant application.

Claims 1, 5-7 and 9-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,741,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the methods for producing hybrid seed comprising crossing a male sterile plant, transformed with an antisense gene which renders pollen-producing cells susceptible to an antibiotic or herbicide, with a male fertile plant which comprises a sense antibiotic- or herbicide-resistance gene which negates the disruption caused by the antisense sequence, and the resultant hybrid seed, as claimed in the patent, to obtain the methods for producing hybrid seed comprising crossing a male sterile plant, transformed with an antisense gene which renders pollen-producing cells susceptible to an

antibiotic or herbicide, with a male fertile plant which negates the disruption caused by the antisense sequence, and the resultant hybrid seed, as claimed in the instant application.

Claims 4, 9-12 and 15-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,013,859. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the method of producing hybrid seed comprising crossing a male sterile plant, transformed with a first gene encoding an enzyme which converts a non-toxic substance into a toxic substance, said first gene linked to a second gene which confers resistance to a selection agent including an herbicide, with a male fertile plant comprising a restorer gene encoding an antisense RNA corresponding to the first gene, and hybrid plants produced thereby, as claimed in the patent; to obtain the method of producing hybrid seed comprising crossing a male sterile plant, transformed with a first gene encoding an enzyme which converts a non-toxic substance into a toxic substance, said first gene linked to a second gene which confers resistance to a selection agent comprising an antibiotic or an herbicide, with a male fertile plant comprising a restorer gene encoding an antisense RNA corresponding to the first gene, and hybrid plants produced thereby, as claimed in the instant application.

Claims 3-4 and 9-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 34, 42, 45, 48, 71, 82-87, 90-91 and 93-94(a)(iv) of copending Application No. 08/359,938. Although the conflicting

claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the methods of producing hybrid seed comprising crossing a male sterile plant transformed with a first gene encoding either a cytotoxic molecule or an enzyme which converts a non-toxic substance into a toxic substance, said first gene linked to a second gene which confers resistance to a chemical selection agent which would include an herbicide or an antibiotic, with a male fertile plant comprising a restorer gene encoding an antisense RNA corresponding to the first gene, and hybrid plants produced thereby, as claimed in the copending application; to obtain the method of producing hybrid seed comprising crossing a male sterile plant, transformed with a first gene encoding a cytotoxic product or an enzyme which converts a non-toxic substance into a toxic substance, said first gene linked to a second gene which confers resistance to a selection agent comprising an antibiotic or an herbicide, with a male fertile plant comprising a restorer gene encoding an antisense RNA corresponding to the first gene, and hybrid plants produced thereby, as claimed in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered

not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claims 1, 5-7 and 9-11 are rejected under 35 U.S.C. 102(g) as being anticipated by Mariani et al.

In addition to encompassing the inventions discussed above, claim 1 and dependents also encompass a method of producing hybrid seed comprising crossing a male sterile plant comprising a cytotoxic gene under the control of a male reproductive cell-specific promoter with a male fertile plant which compensates for the disruption of pollen formation caused by the cytotoxic gene, and the resultant hybrid seed. Such subject matter was awarded to Mariani et al in Interference No. 103,885.

Claims 3-4 and 12-16 are deemed free of the prior art, as stated previously.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

July 22, 2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638